

REMARKS

With the foregoing amendment claims 1-17 and 19-21 are pending in the application. Claims 1, 9, and 20 are independent. No new matter has been added by the amendments. Applicants respectfully request reconsideration of the present application.

I. Claim Rejection Under 35 U.S.C. 101

The Office Action states, “the claimed invention is directed to non-statutory subject matter.” However, the Office Action does not expressly state exactly which claim or claims is rejected as being non-statutory. It appears as though the rejection may be directed to claim 20. If this is the case, Applicant respectfully disagrees. Claim 20 is directed to a “system.” A “system” is clearly a category of statutory subject matter. Additionally, claim 20, as amended, requires that the code means be stored on a computer readable medium. It is well settled law that a computer readable medium storing software is statutory.

II. First Claim Rejection(s) Under 35 U.S.C. 103

Claims 1-15 and 20-21 stand rejected under 35 U.S.C. 103 as being unpatentable over Tsai (US 6,839,741) in view of Collins (US 2002/0013817). Applicants respectfully traverse.

Independent Claim 1

Claim 1 is directed to an e-mail system that notifies an intended recipient of the existence of information that was transmitted to the intended recipient but never received by the recipient because the information was bounced by the intended recipient’s e-mail server.

Claim 1 is patentable over Tsai in view of Collins because neither Tsai nor Collins, considered alone or in combination, teach or suggest all of the features of claim 1. For example, at the least, neither Tsai nor Collins, considered alone or in combination, teach or suggest an e-mail system wherein “automatically in response to determining that said previous e-mail message was not received by the intended recipient, said e-mail system posts at least a portion of said previous e-mail message to said undelivered data storage in

said server and sends a notification e-mail message to the intended recipient notifying the intended recipient of the existence of the previous e-mail message,” as is recited in claim 1.

Tsai is directed to a method of sending a file to a recipient. Conventionally, most people send a file to a recipient by attaching the file to an e-mail message and then sending the e-mail message together with the attached file to the recipient. Tsai discloses that it would be better if the file attached to e-mail message was not transmitted to the recipient together with the e-mail message, but rather posted to an attachment server, thereby enabling the recipient to download the file from the attachment server whenever it is convenient for the recipient. For example, at column 3, lines 14-24, Tsai states,

In a first alternate implementation, a sender of an email posts an attachment on the server and sends the textual portion of the email onto the recipients. In a second alternate implementation, the sender sends the email with the attachment towards the recipients. An attachment server receives the email and strips the attachment from the email. The textual portion of the email is sent onto the recipients and the recipients are notified that the attachment has been removed. The attachment is stored at the attachment server for access by the recipients.

Accordingly, Tsai discloses posting an attachment to an attachment server.

The Office Action notes that Tsai does not “expressly disclose electronic mail system examines a received e-mail message to determine whether a previous e-mail message was not received by an intended recipient of the previous e-mail message.” Applicant agrees with the Office Action’s characterization of Tsai.

Claim 1, as now amended, requires that, “in response to determining that said previous e-mail message was not received by the intended recipient, said e-mail system posts at least a portion of said previous e-mail message to said undelivered data storage” Because Tsai does not disclose “determining that said previous e-mail message was not received ...,” it is impossible for Tsai to disclose posting at least a portion of said previous e-mail message in response to determining that said previous e-mail message was not received. That is, it is impossible for the system disclosed in Tsai to take an action in

response to a step that it never performs. Accordingly, Tsai does not teach or suggest all of the features of claim 1.

Collins does not make up for the deficient teachings of Tsai because Collins does not teach or suggest a system wherein “in response to determining that said previous e-mail message was not received by the intended recipient, said e-mail system posts at least a portion of said previous e-mail message to said undelivered data storage ...,” as is recited in claim 1.

Collins merely discloses that, in some cases, an e-mail sent to an intended recipient is not received by the intended recipient because the e-mail server that manages the intended recipient's e-mail account refuses to accept the e-mail message (i.e., “bounces” the e-mail message). Collins discloses that the e-mail server may “bounce” an e-mail having an attachment because of a size restriction. However, the only solution Collins provides to this problem of bounced messages is to never send a file greater than a certain size to those recipients whose e-mail servers have a size restriction. See page 4, paragraph 0054 (“In such a situation, the program of the present invention advantageously provides for an absolute block to be set in relation to users who have a known restriction on permitted attachment size”). Accordingly, unlike the invention of claim 1, Collins does not disclose “in response to determining that said previous e-mail message was not received by the intended recipient, said e-mail system posts at least a portion of said previous e-mail message to said undelivered data storage ...,” as is recited in claim 1. Thus, Collins does not make up for the deficient teachings of Tsai. Applicant, therefore, respectfully requests that the rejection of claim 1 over Tsai in view of Collins be withdrawn.

Dependent Claims 2-8

Claims 2-8 depend from claim 1. Therefore, claims 2-8 are patentable over the art of record for at least the same reasons give above with respect to claim 1.

Independent Claims 9 and 20

Applicant submits that the above remarks for claim 1 apply equally to independent claims 9 and 20 because, like claim 1, claim 9 requires “receiving a second e-mail message

after sending the first e-mail message, determining if the size of the first e-mail message exceeds a size limit, wherein the determination is based, at least in part, on information included in the second e-mail message, [and] posting at least a portion of said first e-mail message to a server ... automatically in response to determining that the size of the first e-mail message exceeds the size limit.” and claim 20 requires “receiving a message from an e-mail server associated with the recipient’s e-mail account ... determining whether the message indicates that the size of the first e-mail message exceeds a size limit ... [and] automatically transmitting a second e-mail message to the recipient’s e-mail account in response to determining that the first e-mail message exceeds the size limit.”


III. Second Claim Rejection(s) Under 35 U.S.C. 103

Claims 16-19 stand rejected under 35 U.S.C. 103 as being unpatentable over Tsai in view of Collins and Freed (US 2003/0055903). Claims 16-19 depend from claim 9. Accordingly, claims 16-19 are patentable for at least the reasons give above with respect to claim 9.

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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